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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,180	12/20/2000	Vincenzo D'Acchioli	CM1987QVB	8836

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EXAMINER

ANDERSON, CATHARINE L

ART UNIT PAPER NUMBER

3761

DATE MAILED: 07/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary

Application No.

09/720,180

Applicant(s)

D'ACCHIOLI ET AL.

Examiner

C. Lynne Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 April 2003 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The placement of the absorbent material on the inner surface of the inner lining is not disclosed in the specification. The specification discloses, on page 10, lines 6-8, that the absorbent material may be secured to the inner layer of the bag, but does not specifically disclose the absorbent material secured to the inner surface of the inner layer. Claim 12 further discloses a second absorbent material that is not joined to the inner lining. The combination of a

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first absorbent material joined to the inner lining and a second absorbent material not joined to the inner lining is not disclosed in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al. (5,417,677).

Schneider discloses a flexible bag 10, as shown in figure 2, comprising an aperture 20 and a flange 21 surrounding the aperture 20. The flange 21 has a wearer facing portion and a garment facing portion, the wearer facing portion comprising a layer of adhesive 22. The flange 21 is provided with at least one non-adhesive lobe 21a, as shown in figure 2. The flexible bag 10 comprises an inner lining 15, as shown in figure 2, opposite the aperture 20. The flexible bag 10 further comprises an absorbent material 25 disposed on the inner lining 15, as shown in figure 5, and described in column 5, lines 47-54. The flexible bag 10 is fully capable of being attached to the urogenital area of a wearer to collect urine.

With respect to claim 2, the flange 21 comprises at least two non-adhesive lobes, as disclosed in column 4, lines 46-50.

With respect to claim 3, the flange 21 comprises one lobe 21a positioned at the upward end of the flange 21, as shown in figure 1.

With respect to claim 4, the non-adhesive lobe 21a is located about the longitudinal axis of symmetry of the flexible bag 10, as shown in figure 1.

~~With respect to claim 5, a release means 23 covers the layer of adhesive 22 and the non-adhesive lobe 21a, as shown in figure 2.~~

With respect to claim 10, the absorbent material 25 is tissue, as disclosed in column 5, lines 47-54, which comprises wood pulp.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (5,417,677) as applied to claim 1 above, and further in view of Allen, Jr. et al. (4,561,858).

Schneider discloses all aspects of the claimed invention with the exception of the release means extending beyond the edges of the flange. Allen, Jr. discloses a bag for collecting body fluids, as shown in figure 3, comprising an aperture 14 and a flange 26. The flange 26 is tacky so it may adhere to the skin of the wearer, as disclosed in column 4, lines 25-34. The adhesive flange 26 is covered with a release means 28, which extends beyond the edges of the flange 26 to protect the flange 26 from dust prior to use. The free edges of the release means 28 provide a convenient place for gripping

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the release means 28 in order to remove it from the flange 26, as disclosed in column 4, lines 39-45.

It would therefore be obvious to one of ordinary skill in the art at the time of invention to extend the release means of Schneider beyond the edge of the flange in order to provide a free edge of the release means that may be more easily gripped while removing the release means from the flange, as taught by Allen, Jr.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (5,417,677) as applied to claim 10 above.

Schneider discloses all aspects of the claimed invention with the exception of absorbent gelling materials. Absorbent gelling materials are well-known in the art to offer superior absorbent qualities. It would therefore be obvious to one of ordinary skill in the art at the time of invention for the absorbent material of Schneider to comprise absorbent gelling materials to improve the absorbent qualities of the absorbent material.

Response to Amendment

The amendment filed 03 April 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The placement of the absorbent material on the inner surface of the inner lining and the disclosure of a second absorbent material.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed 03 April 2003 have been fully considered but they are not persuasive. The examiner has mistakenly identified the inner lining of the flexible bag 10 disclosed by Schneider et al. (5,417,677) as being shown in the figures by reference numerals 11 and 12. According to the instant specification, the inner lining disclosed in the instant claims is the wall of the flexible bag located opposite the aperture and flange. The inner lining of Schneider may, therefore, be defined as shown in the figures by reference numeral 15, the wall of the flexible bag 10 opposite the aperture 20 and flange 21. The absorbent material 25 of Schneider is therefore disposed on and joined to the inner lining 15 of the bag 10.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,491,673 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A bag comprising an inner layer, an aperture, a flange, and an absorbent material.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (703) 306-5716. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

CWA
cla
July 11, 2003


Aaron J. Lewis
Primary Examiner